

REMARKS

By this amendment, Applicant amends claims 1, 4, 5, 9, 12, 14, 15, 17, 21, 24, 27, and 31, cancels claims 2, 3, 6, 7, 10, 11, 13, 22, and 25 without prejudice or disclaimer, and adds new claims 33 and 34. Accordingly, claims 1, 4, 5, 8, 9, 12, 14-21, 23, 24, and 26-34 are now pending in this application.

In the Office Action,¹ the Examiner took the following actions:

rejected claims 1-7, 9-15, 21, 22, 24, 25, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Bull et al. (U.S. Patent No. 5,995,943) in view of Rodkin et al. (U.S. Patent No. 6,092,074);

rejected claims 8, 16, 23, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin and in further view of Kirsch et al. (U.S. Patent No. 6,189,030);

rejected claims 17, 18, 27, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin and in further view of Murray (U.S. Patent No. 6,061,659); and

rejected claims 19, 20, 29, 30, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin, Murray, and Kirsch.

I. REJECTION OF CLAIMS 1-7, 9-15, 21, 22, 24, 25, AND 31 UNDER § 103(a)

Applicant respectfully traverses the rejection of claims 1-7, 9-15, 21, 22, 24, 25, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin et al. The rejection with respect to cancelled claims 2, 3, 6, 7, 10, 11, 13, 22, and 25 is now moot.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1, as amended, recites an apparatus for hyperlinking specific words in content to convert the words into advertisements including, among other things, “code” in a content file that:

(1) “references said ad server to determine at least one existing advertiser-chosen word present in said content file”

and

(2) “automatically, when said content file is interpreted by a web browser, providing a hypertext anchor for said at least one existing advertiser-chosen word, thereby converting said at least one existing advertiser-chosen word into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page” (emphasis added).

The cited references do not teach or suggest at least these elements of independent claim 1.

Bull discloses that pre-prepared ads are inserted into a web page. For example, Fig. 6 of Bull shows an arrow labeled “GET AD TO INSERT,” indicating that an ad is retrieved from advertising database 250. After retrieving the ad, the Bull system will then “cause an advertisement/coupon to be added into the display.” See col. 12, lines 15-16. While Bull teaches that page content in the form of an ad is added, Bull does not teach or suggest Applicant’s claimed “code” in a content file that:

(1) “references said ad server to determine at least one existing advertiser-chosen word present in said content file”

and

(2) “automatically, when said content file is interpreted by a web browser, providing a hypertext anchor for said at least one existing advertiser-chosen word, thereby converting said at least one existing advertiser-chosen word into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page” (emphasis added).

The Office Action admits that Bull does not teach “means for providing a hypertext anchor to convert at least one existing advertiser-chosen work present in a content file into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page” (emphasis in original). Office Action at page 3. The Office Action then alleges that Rodkin compensates for this deficiency of Bull. Applicant disagrees because Rodkin does not compensate for the deficiencies of Bull outlined above.

For example, Rodkin discloses:

The Intelligent Annotator™ traverses the text of the article. That is, each word or phrase is examined to determine whether the text should be converted to hypertext. Moreover, for words or phrases which already have conventional hypertext anchors, the new anchor data in accordance with the present invention can either overwrite the old anchor data, or be inserted along with the old anchor data. Therefore, the article to be annotated 405 may be a text file with no hyperlinks, or a file with conventional hyperlinks. Additionally, as mentioned, the article to be annotated need not be a discrete file, but may comprise computer information from any source, and in any format.

Col. 15, lines 36-47.

Accordingly, Rodkin discloses determining whether text should be converted to hypertext. However, Rodkin does not teach or suggest Applicant's claimed “code” in a content file that:

(1) “references said ad server to determine at least one existing advertiser-chosen word present in said content file”

and

(2) “automatically, when said content file is interpreted by a web browser, provides a hypertext anchor for said at least one existing advertiser-chosen word, thereby converting said at least one existing advertiser-chosen word into an

advertisement by linking said at least one advertiser-chosen word to said advertiser web page” (emphasis added).

As explained above, the elements of independent claim 1 are neither taught nor suggested by the cited references. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, no reason has been clearly articulated as to why independent claim 1 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1 and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Independent claims 9, 21, 24, and 31 although of a different scope from independent claim 1 and each other, include recitations similar to those discussed above in connection with independent claim 1. Accordingly, a *prima facie* case of obviousness has not been established for independent claims 9, 21, 24, 31 for at least the reasons discussed above. Furthermore, claims 4, 5, 12, 14, and 15 are allowable at least due to their dependence from independent claims 1 and 9. Therefore, the Examiner should also withdraw the rejection of claims 4, 5, 9, 12, 14, 15, 21, 24, and 31 under 35 U.S.C. § 103(a).

Independent claim 31 further recites “displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink.” The Office Action admits that “Bull et al. does not explicitly teach (independent claim 31) displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink” (emphases in original). See page 4. The Examiner then alleges that

principles of inherency make up for this admitted deficiency of Bull. Applicant disagrees.

MPEP § 2112.02 explains that, “[u]nder the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process.” See MPEP § 2112.02, citing *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). The Office Action cites a portion of Bull that “teaches clicking on a URL ... to access a Web page.” See page 4. Regarding this teaching, the Office Action further alleges that “[t]he mouse pointer must inherently be positioned over the URL link in order to activate said link by clicking on it.” However, positioning a mouse pointer over a URL link in order to click on the link does not constitute “displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink,” as recited in claim 31 (emphasis added).

Moreover, the principles of inherency do not apply in the present instance, because nothing in Bull indicates that it would “necessarily perform the method claimed,” as required by MPEP § 2112.02. Instead, Bull only discloses clicking a URL; but does not teach “displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink,” as recited in claim 31 (emphasis added). Nor does Rodkin compensate for this deficiency of Bull. Accordingly, the rejection of independent claim 31 is improper for at least this additional reason.

II. REJECTIONS OF CLAIMS 8, 16-20, 23, 26-30, AND 32 UNDER § 103(a)

Applicant respectfully traverses the rejection of claims 8, 16, 23, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin and in further view of Kirsch; the rejection of claims 17, 18, 27, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin and in further view of Murray; and the rejection of claims 19, 20, 29, 30, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin, Murray and Kirsch.

Independent claim 17, although of a different scope from independent claim 1, includes recitations similar to those discussed above in connection with independent claim 1. As discussed above, Bull and Rodkin do not teach or suggest all of the elements of independent claim 1. Furthermore, Murray and Kirsch do not compensate for the deficiencies of Bull and Rodkin. That is, Murray and Kirsch also do not teach or suggest at least Applicant's claimed "code" in a content file that (1) "references said ad server to determine at least one existing advertiser-chosen word present in said content file" and (2) "automatically, when said content file is interpreted by a web browser, providing a hypertext anchor for said at least one existing advertiser-chosen word, thereby converting said at least one existing advertiser-chosen word into an advertisement by linking said at least one advertiser-chosen word to said advertiser web page," as recited in independent claim 1, and similar recitations of independent claim 17.

As explained above, the elements of the independent claims are neither taught nor suggested by the cited references. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the

differences between the prior art and the claimed invention. Accordingly, no reason has been clearly articulated as to why independent claim 17 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 17 and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Independent claim 27, although of a different scope from independent claim 1 and 17, includes recitations similar to those discussed above in connection with independent claims 1 and 17. Accordingly, a *prima facie* case of obviousness has not been established for independent claim 27 for at least the reasons discussed above. Furthermore, claims 8, 16, 18-20, 23, 26, 28-30, and 32 are allowable at least due to their dependence from independent claims 1, 9, 17, 21, 27, and 31. Therefore, the Examiner should also withdraw the rejection of claims 8, 16, 18-20, 23, 26-30, and 32 under 35 U.S.C. § 103(a).

III. NEW CLAIMS 33 AND 34

Although of a different scope, new claims 33 and 34 include recitations similar to those discussed above in connection with the allowable independent claims. Accordingly, Applicant requests the Examiner to allow new claims 33 and 34 over the cited references for at least the reasons discussed above.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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